

REMARKS

Applicant has carefully studied the Final Office Action of February 27, 2006 and offers the following remarks.

Before addressing the rejections, Applicant provides a brief overview of the invention and of the Johnson et al. (hereinafter "Johnson") reference. Applicant's invention is directed to a method and system for efficiently transporting digital files over a peer-to-peer network. The network includes at least one server node and multiple client nodes. When a digital file is to be transferred over the network from a sending node to a receiving node, other nodes are allowed to submit bids to transport the file over the peer-to-peer network for a particular price. The node with the lowest bid is then allowed to transport the file to the receiving node, thereby optimizing network traffic based on economics. In contrast, Johnson is directed to a method and system where telecommunication switches route toll-free calls in accordance with least cost routing resulting from an auction process between participating carriers. A moderator provides each carrier with bid information from other carriers so that the carriers will have the opportunity thereafter to submit a lower or higher bid. (Johnson, Abstract) In this arrangement, the carriers send to the moderator the rate it is willing to charge for service between two specific switching points on one or more telecommunication networks, from an originating switching point to a toll-free call's specific switching point, at some particular time. (Johnson, col. 2, lines 59-65, emphasis added).

Claims 1-3, 10-12, 19, 26, 45 and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Carlton-Foss. Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Once a proper combination is made, for the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element can be found in the combination of references. MPEP § 2143.03.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts that the motivation to combine the references is "to allow the bidder to submit/transmit data across network using peer-to-peer network securely." (Final Office Action mailed February 27, 2006,

page 3, lines 1-4). This asserted motivation lacks the actual evidence required by the Federal Circuit in *Dembiczak*. Lacking the required evidence of motivation, the combination cannot support the obviousness rejection.

In addition, Applicant submits there is no need for Johnson to look to Carlton-Foss to submit data securely and therefore no need to use a peer-to-peer network since Johnson is directed to the routing of toll-free calls. To the extent there would be such a need, the Examiner provides no evidence to support it. Johnson is not even analogous art. It is directed to telecommunication network control, specifically low cost routing of toll-free calls, and therefore is not in the field of Applicant's endeavor. MPEP §2141.01(a). Johnson is also not reasonably pertinent to the particular problem with which the inventor was concerned, namely efficiently transporting digital files stored in centralized servers on a peer-to-peer network. (*Id.*; see Specification, pp. 1-4). Since Johnson is not analogous art and there is no evidence to support the motivation to make the proposed combination, the combination is improper. Applicant therefore requests withdrawal of the § 103 rejection and allowance of the rejected claims on this basis.

Applicant notes that Carlton-Foss has been cited by the Examiner only to teach a peer-to-peer network, and that the Examiner alleges Johnson teaches all of the other limitations of claims 1-3, 10-12, 19, 26, 45 and 46. The Examiner also states that Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new grounds of rejection. Applicant respectfully disagrees. Since the Examiner is still relying on Johnson to teach the elements of the claims other than a peer-to-peer network, Applicant's previous arguments are not moot. Applicant hereby summarizes and incorporates its previous arguments that Johnson does not teach the elements of claims 1-3, 10-12, 19, 26, 45 and 46.

Johnson does not teach **"when a digital file is to be transferred over the peer-to-peer network from a sending node to a receiving node, allowing other nodes to submit bids to transport the file over the network for a particular price. . ."** (emphasis added). The Patent Office asserts this element is shown by Johnson's abstract; col. 2, line 45-col. 3, line 26; col. 3, lines 46-65; and col. 20, lines 30-44. Applicant respectfully traverses this assertion. While Johnson's passages do discuss the transmission of data and video over the network, the bid is not submitted **"when a digital file is to be transferred,"** as recited in the claim. Rather, the bids are submitted

independently of the presence or absence of a file and are based instead on time and bandwidth availability.

Johnson's abstract describes a bidding service, wherein carriers submit bids and the moderator provides the carriers with information about the bids of other carriers, for at least a portion of all point-to-point routes for which any carrier has submitted a bid. Nothing in the abstract describes the timing or event that triggers the bid. Certainly, there is no teaching within the abstract that the bids are allowed "when a digital file is to be transferred," as recited in claim 1. Johnson also discusses the submission of bids by the carriers to the moderator and further indicates that the bid may be for routes over different types of communication networks and for different classes of telecommunication services provided by such networks (data, audio, or video). (Johnson, col. 3, lines 14-19). However, the bids are submitted for providing service between two specific switching points on one or more telecommunications networks from an originating switching point to a terminating switching point at some particular time (see Johnson, col. 2, lines 59-65). There is no indication that the submission of bids is tied to "when a digital file is to be transferred," as recited in claim 1. In fact, there is no submission of bids to transport the file; the submission of bids is for providing service between two switching points. Johnson, in col. 3, lines 36-65, indicates that the bids are sent to the other carriers so that the bids may be adjusted if needed or desired. However, nothing in this passage ties the submission of the bids to "when a digital file is to be transferred," as recited in claim 1. Thus, this passage does not teach the claim element. Johnson, in col. 20, lines 30-44, confirms that voice, data, and video communication services are contemplated over packet data networks. However, this passage does not indicate that the submission of bids occurs "when a digital file is to be transferred," as recited in claim 1. Thus, this passage does not teach the claim element.

In short, the Patent Office is ignoring an explicit portion of the claim. The claim requires allowing the bids to be submitted when the digital file is to be transferred. Johnson does not link the bid submission to this condition. Instead, Johnson contemplates bids for service between two switching points for whatever service is required. The distinction is even more pronounced when two other facts are considered: (1) Johnson teaches that the bid is for service between two switching points at some particular time (Johnson, col. 2, lines 59-65); and (2) Johnson's system teaches that the results of the bidding process are updated only periodically (Johnson, col. 4, lines 10-12). Since Johnson discloses bids that are for services at some particular time and the

results of the bidding process is only updated periodically (so that carriers have a chance to adjust their bid), it is clear that the submission of bids in Johnson is not “when a digital file is to be transferred over the network.” Thus, Johnson does not teach or suggest “when a digital file is to be transferred over the network from a sending node to a receiving node, allowing other nodes to submit bids to transport the file over the peer-to-peer network for a particular price.” Carlton-Foss, cited only for disclosing a peer-to-peer network, does not cure the deficiencies of Johnson. Since the references individually do not teach or suggest each and every limitation of claim 1, the combination does not teach or suggest each and every limitation of claim 1. Claim 1 is therefore patentable over Johnson and Carlton-Foss. Claims 2 and 3 depend from claim 1 and are not obvious for at least for the same reasons.

Claim 3 is patentable for a separate reason. Claim 3 recites “billing the user of the sending node.” In contrast, Johnson is a 1-800 billing system. The carriers bill the 800 customer for using the node, not the sender (see Johnson, col. 2, lines 20-22). The Patent Office asserts that this element is shown by Johnson, col. 22, lines 25-65. Applicant respectfully traverses this assertion. The passage cited by the Examiner confirms that the 800 customer is billed, not the sending node. Thus, this passage actually teaches the opposite of what is claimed. Since this passage teaches the opposite of what is claimed, Johnson does not teach or suggest each and every element of claim 3. Carlton-Foss does not cure the deficiencies of Johnson with respect to claim 3. Since the references individually do not teach or suggest each and every limitation of claim 3, the combination does not teach or suggest each and every limitation of claim 3. Claim 3 is therefore patentable over Johnson and Carlton-Foss.

Claim 12 (“wherein a user of the sending node is billed”), claim 19 (“billing a user account of the sending node”), and claim 33 (“automatically billing the user’s account”) also recite a similar limitation to claim 3 and are separately patentable for the reasons set forth above with respect to claim 3.

Claim 10 is directed to a peer-to-peer network. Applicant initially notes that Johnson does not disclose a peer-to-peer network. Although Carlton-Foss does mention a peer-to-peer network, to reach the claimed invention of claim 10, the appropriate combination would have to be the network of Carlton-Foss and the system of Johnson. As set forth above, the Examiner has failed to support the motivation to combine these references with the requisite evidence, and Johnson is non-analogous art and cannot be combined with Carlton-Foss to attempt to teach or

suggest the claimed invention. Moreover, Applicant respectfully submits that no one of ordinary skill in the art, given the non-analogous nature of Johnson, would look to combine Johnson with the teachings of Carlton-Foss. In addition, trying to combine the system of Johnson with Carlton-Foss would render Carlton-Foss unsuitable for its intended purpose of conducting an interactive reverse auction over a computer network. Since the combination of Carlton-Foss and Johnson is therefore improper, claim 10 and the claims that depend from claim 10 are patentable.

In addition, claim 10 recites “means for allowing other nodes to submit bids to transport a digital file over the network for a particular price **when the file is to be transferred from a sending node to a receiving node. . .**” (emphasis added). The highlighted portion of the claim is essentially the same as that addressed above with respect to claim 1; thus, claim 10 is allowable for the same reasons. Claims 11-18 depend from claim 10 and are allowable at least for the same reasons.

Claim 19 recites “when a digital file is to be transferred over the peer-to-peer network from a sending node to a receiving node, allowing other nodes to submit bids to transport the file. . .” (emphasis added). This element is essentially the same as that addressed above, with respect to claim 1; thus, claim 19 is allowable for the same reasons. Claims 20-25 depend from claim 19 and are allowable at least for the same reasons.

Claim 26 recites “means for allowing other nodes to submit bids to transport a digital file over the network for a particular price when the file is to be transferred over the network from a sending node to a receiving node. . .” (emphasis added). This element is essentially the same as that addressed above with respect to claim 1; thus, claim 26 is allowable for the same reasons. Claims 27-32 depend from claim 26 and are allowable at least for the same reasons.

Claims 45 and 46 correspond to original claims 10 and 26 respectively, but are presented without means plus function language. Claims 45 and 46 are patentable for the same reasons that claims 10 and 26 are patentable.

Claims 4-9, 13-18, 20-25, and 27-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson and Carlton-Foss, and further in view of Odlyzko. Applicant respectfully traverses.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts that the motivation to combine the references is “allowing a user to specify different channels for

different types of communications for obtaining a high quality of service when needed for transmitting electronic files (such as news downloads)." (Final Office Action mailed February 27, 2006, pp. 5-6). As set forth above, the combination of Johnson and Carlton-Foss is improper. The Examiner provides no further explanation of why all three of these references would be combined. Notably, the offered motivation is the same stated motivation supplied by the Examiner when combining only Johnson and Odlyzko in the Office Action mailed September 23, 2005. This asserted motivation lacks the actual evidence required by the Federal Circuit in *Dembiczak*. Lacking the required evidence of motivation, the combination cannot support the obviousness rejection. In addition, Odlyzko, like Johnson, is not even analogous art. Odlyzko is directed to regulation of telecommunications network traffic, particularly limiting congestion in a packet switched network, and therefore is not in the field of Applicant's endeavor. MPEP §2141.01(a). Odlyzko is also not reasonably pertinent to the particular problem with which the inventor was concerned, namely efficiently transporting digital files stored in centralized servers on a peer-to-peer network. (*Id.*; see Specification, pp. 1-4). Since Johnson and Odlyzko are non-analogous art and there is no evidence to support the motivation to make the proposed combination, the combination is improper. Applicant therefore requests withdrawal of the § 103 rejection and allowance of the rejected claims on this basis.

Applicant further traverses the rejection because, as explained above, Johnson does not teach that the bids are allowed "when a digital file is to be transferred," as recited in the claims. Nothing in Carlton-Foss or Odlyzko cures the deficiencies of Johnson. Since the references individually do not teach or suggest the claim element, the combination cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness.

Claims 33-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Odlyzko and Barzilai et al. (hereinafter "Barzilai"). Applicant respectfully traverses. The standards for establishing obviousness are set forth above

Applicant initially traverses the rejection because the Patent Office still has not set forth the actual evidence to combine Johnson and Odlyzko, as explained above. Since this underlying combination is improper, the rejection is improper. Since the rejection is improper, the claims are allowable.

Applicant further traverses the rejection because the Patent Office has not properly supported the motivation to combine Barzilai with the other references. Specifically, the Patent Office states that the motivation is “to allowing [sic] a paying members to submit bids for different channels for different types of communications for obtaining a high quality of service when needed for transmitting electronic files” (Final Office Action mailed February 27, 2006, page 8, lines 18-20). This asserted motivation also lacks the evidence required by the Federal Circuit in *Dembiczak*. Lacking the required evidence of motivation, the combination cannot support the obviousness rejection. Applicant therefore requests withdrawal of the § 103 rejection and allowance of the rejected claims on this basis.

Applicant further traverses the rejection because the rejection does not establish obviousness. Claim 33 recites “accepting bids to transport the file from other nodes”. As discussed above, Johnson does not bid on transporting a particular file, as recited in the claim. Johnson’s bids are for a particular time and a particular originating switch and terminating switch. Johnson does not teach bidding on transporting a particular file. The Patent Office points to nothing in Odlyzko or Barzilai that cures the deficiencies of Johnson. Thus, the combination of references does not teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness.

Claim 33 also recites “in response to the user publishing one or more files, prompting the user to select a quality of service for file delivery.” The Patent Office seems to be saying that the distributing discussed at col. 3, lines 47-55 of Johnson teaches this limitation. The cited passage only discloses that after a new bid is submitted by a carrier and processed by the moderator, the moderator will distribute at least a portion of the bid information to other carriers. First of all, the distributing of bid information in Johnson is not the user publishing one or more files, as claimed in claim 33. Second, the moderator of Johnson is not the user of the claims. Finally, there is no disclosure of prompting the user to select a quality of service for file delivery. Therefore, Johnson does not teach or suggest all of the elements of claim 33. The Patent Office points to nothing in Odlyzko or Barzilai that cures the deficiencies of Johnson. Thus, the combination of references does not teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness.

Claims 34-44 depend from claim 33 and are allowable at least for the same reasons.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. The cited references do not teach or suggest each and every element of the claims, and the Patent Office is impermissibly combining the references. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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